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REMARKS

This Amendment is submitted in response to the Office Action dated February 8, 2007. In the Office Action, the Patent Office rejected Claim 5 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Further, the Patent Office rejected Claims 1, 2 and 4 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,334,218 to *Johnson*; rejected Claims 37, 38, 40 and 41 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,620,011 to *Flowers*; rejected Claims 37 and 38 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,666,974 to *Hiro*; and rejected Claims 37, 38, 41 and 42 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,448,738 to *Berghash*. Still further, the Patent Office rejected Claim 6 under 35 U.S.C. §103(a) as being unpatentable over *Johnson* in view of U.S. Patent No. 3,669,117 to *Herbst*. Moreover, the Patent Office objected to Claims 3, 27 and 39 as being dependent upon a rejected base claim.

By the present Amendment, Applicant amended Claims 1, 4, 5, 22, 27, 37 and 41 and added Claims 47-49. Applicant asserts that the amendments to the claims and the remarks that follow overcome the objection and rejections made by the Patent Office and place the application in condition for allowance.

Applicants note with appreciation that the Patent Office allowed Claims 7-26, 28-36 and 43-46 and indicated that Claims 3, 27 and 39 would be allowable if re-written in independent form including all of the limitations of the base claim and any intervening claims. To this end, Applicants added new Claims 47-49 substantially incorporating the elements of dependent Claim 3 with independent Claim 1, dependent Claim 27 with independent Claim 1 and dependent Claim 39 with independent Claim 37, respectively. Accordingly, Applicants submit that new Claims 47-49 are in allowable form.

In the Office Action, the Patent Office rejected Claim 5 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More specifically, the Patent Office alleged that the element of the depression in the shelf in dependent Claim 5 contradicted that the shelf was described as planar in independent Claim 1. Claim 5 has been amended to remove reference to a depression in the shelf. Applicant asserts that the rejection of Claim 5 under 35 U.S.C. §112, second paragraph, has been overcome and should be withdrawn. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claims 1, 2 and 4 under 35 U.S.C. §102(b) as being anticipated by Johnson. More specifically, the Patent Office alleges that Johnson discloses

a pacifier having a planar shield, a bulb and a U-shaped planar shelf having planar top and bottom sides, front and back sides, a length, a thickness and width.

Independent Claim 1, as amended, requires walls integrally formed with the shelf wherein the walls guide the teeth of the user. *Johnson* merely discloses an infant pacifier/teether having a nipple member with a bulbous forward portion and a rearward portion. The rearward portion extends forwardly from an enlarged diameter shield. A handle is affixed to the rearward surface of the shield and a semi-circular teething member extends forwardly of the shield adjacent the nipple member. The teething member is sized and configured to conform to the shape of the alveolar ridge of an infant. The teething member has flat upper and lower surfaces. (*Johnson*, FIGS. 1 and 2) Nowhere does *Johnson* disclose walls integrally formed with the shelf wherein the walls guide the teeth of the user as required by amended Claim 1.

Under 35 U.S.C. §102(b), anticipation requires that a single reference discloses each and every element of Applicant's claimed invention. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ 2d. 1241, 1245 (Fed. Cir. 1986). Moreover, anticipation is not shown even if the differences between the claims and the reference are "insubstantial", and one skilled in the art could supply the missing elements. *Structure Rubber*

Products Co. v. Park Rubber Co., 749 F.2d. 707, 716, 223 USPQ 1264, 1270 (Fed. Cir. 1984).

Since *Johnson* fails to disclose the elements specifically defined in amended independent Claim 1, Applicant asserts that the rejection of Claims 1, 2 and 4 under 35 U.S.C. §102(b) has been overcome and should be withdrawn. Notice to that effect is requested.

Further, the Patent Office rejected Claims 37, 38, 40 and 41 under 35 U.S.C. §102(b) as being anticipated by *Flowers*. More specifically, the Patent Office alleges that *Flowers* discloses a U-shaped shelf having a top, bottom, front, back and two ends. Further, the Patent Office alleges that the shelf has top and bottom depressions between the two sides. Still further, the Patent Office alleges that a gel is inside the shelf.

Independent Claim 37, as amended, requires a shield having a substantially planar body and further having an interior surface directed toward a rear of the mouth of the user when the shield is worn adjacent to the mouth of the user. Further, Claim 37 requires that the shelf is made from a material that illuminates in a dark environment.

Flowers merely discloses a diver's mouthpiece having a mouthpiece portion, a pair of teething members formed on the inner wall of the rear portion, a pocket formed in each of the teething members. *Flowers* also discloses that the pocket sized and shaped

to receive a mint gel capsule and the mouthpiece has at least one duct extending from the pocket of each of the teething members to an inner surface of the teething members, so as to allow gel to flow from the pocket containing the gel capsule to the mouth of the diver.

Nowhere does *Flowers* disclose a shield having a substantially planar body and further having an interior surface directed toward a rear of the mouth of the user when the shield is worn adjacent to the mouth of the user as required by amended Claim 37. Further, nowhere does *Flowers* disclose that the shelf is made from a material that illuminates in a dark environment as required by Claim 37.

Since *Flowers* fails to disclose the elements specifically defined in amended independent Claim 37, Applicant asserts that the rejection of Claims 37, 38, 40 and 41 under 35 U.S.C. §102(b) has been overcome and should be withdrawn. Notice to that effect is requested.

Still further, the Patent Office rejected Claims 37 and 38 under 35 U.S.C. §102(b) as being anticipated by *Hiro*. More specifically, the Patent Office alleges that *Hiro* discloses the U-shaped shelf as claimed including a top, bottom, front, back and two ends, as well as different thicknesses of the shelf.

Hiro merely discloses a mouth piece having an intermediate web member, outer wall and inner wall so that the mouthpiece can be

loosely installed to a dental arch of both maxilla teeth and mandibular teeth. Nowhere does *Hiro* disclose a shield having a substantially planar body and further having an interior surface directed toward a rear of the mouth of the user when the shield is worn adjacent to the mouth of the user as required by amended Claim 37. Further, nowhere does *Hiro* disclose that the shelf is made from a material that illuminates in a dark environment as required by Claim 37.

Since *Hiro* fails to disclose the elements specifically defined in amended independent Claim 37, Applicant asserts that the rejection of Claims 37 and 38 under 35 U.S.C. §102(b) has been overcome and should be withdrawn. Notice to that effect is requested.

Still further, the Patent Office rejected Claims 37, 38, 41 and 42 under 35 U.S.C. §102(b) as being anticipated by *Berghash*. More specifically, the Patent Office alleges that *Berghash* discloses a pacifier having a U-shaped shelf with a depression, a bulb and a ring.

Berghash merely discloses a mouthguard with an elongated fastener strap having a bulbous end. Nowhere does *Berghash* disclose a shield having a substantially planar body and further having an interior surface directed toward a rear of the mouth of the user when the shield is worn adjacent to the mouth of the user as required by amended Claim 37. Further, nowhere does *Berghash*

disclose that the shelf is made from a material that illuminates in a dark environment as required by Claim 37.

Since *Berghash* fails to disclose the elements specifically defined in amended independent Claim 37, Applicant asserts that the rejection of Claims 37, 38, 41 and 42 under 35 U.S.C. §102(b) has been overcome and should be withdrawn. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claims 43-46 under 35 U.S.C. §103(a) as being unpatentable over *Johnson* in view of *Herbst*. More specifically, the Patent Office alleges that it would have been obvious to place the gelatinous fluid of *Herbst* into the pacifier of *Johnson*.

Herbst merely teaches a combination teether and pacifier in the form of a thin walled, flexible body having nipple, guard and teething portions which are hollow and in communicating relation to each other. Neither *Herbst* nor *Johnson*, taken singly or in combination, teaches or suggests walls integrally formed with the shelf wherein the walls guide the teeth of the user as required by amended Claim 1.

Moreover, a person of ordinary skill in the art would never have been motivated to combine the teachings of *Herbst* with *Johnson* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). It is submitted that the question under §103 is whether the totality of the art would

collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972). That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Herbst* nor *Johnson* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine *Herbst* with *Johnson* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103. Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office,

the references still lack the novel features positively recited in dependent Claim 6. Accordingly, Applicant asserts that the rejection of Claim 6 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

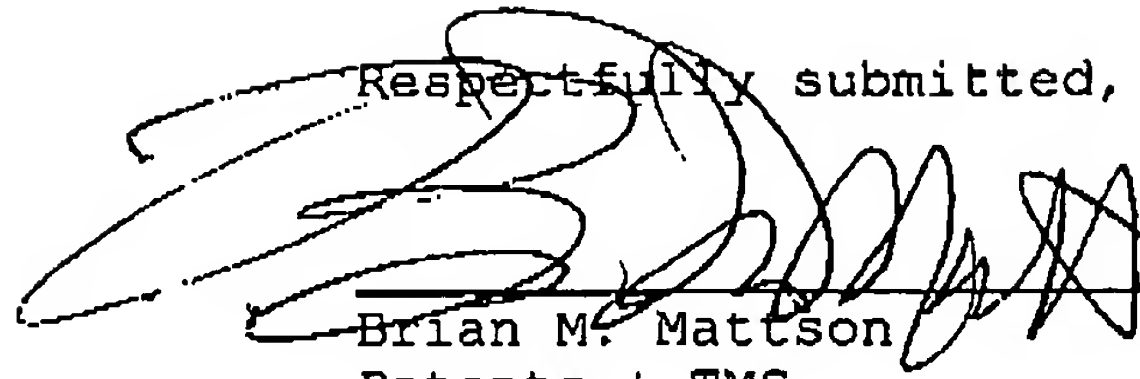
Claims 2-6 depend from Claim 1; Claims 8-13 depend from Claim 7; Claims 15-20 depend from Claim 14; Claims 22-31 depend from Claim 21; Claims 33-36 depend from Claim 32; Claims 38-42 depend from Claim 37; and Claims 44-46 depend from Claim 43. These claims are further believed allowable over the references of record, taken singly or in combination, for the same reasons set forth with respect to their parent claims since each sets forth additional novel features and steps of Applicant's pacifier and method for maintaining proper dentition in a mouth of a user.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. Further, Applicant submits that neither further search nor consideration would be necessitated by entry of this Amendment. Therefore, entry of this Amendment is proper and should be effected. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

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Respectfully submitted,

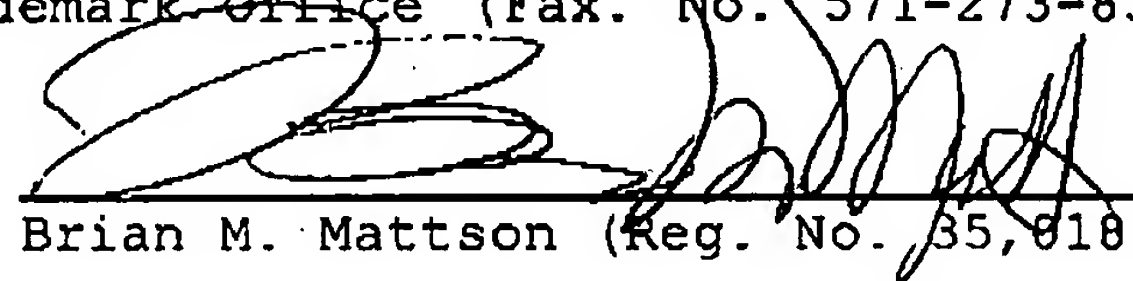


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CERTIFICATE OF TRANSMISSION

I hereby certify that this **Amendment After Final and Transmittal (in duplicate)** are being transmitted by facsimile to the U.S. Patent and Trademark Office (Fax. No. 571-273-8300) on March 7, 2007.



Brian M. Mattson (Reg. No. 35,018)